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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,078	10/06/2000	David Allison Bennett	PSTM0010/MRK/STM	3150

29524 7590 11/30/2004

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EXAMINER

WEBB, JAMISUE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/685,078

Applicant(s)

BENNETT ET AL.

Examiner

Jamisue A. Webb

Art Unit

3629

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date \_\_\_\_\_
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) ☐ Notice of Informal Patent Application (PTO-152)
- Paper No(s)/Mail Date \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

1. This office action is in response to amendment filed September 25, 2004.

***Specification***

2. The use of the trademarks UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express

have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

3. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later
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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-27, and 49-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Fisher et al. (6,047,264) and Kara et al. (6,233,568).

7. With respect to Claims 1, 4, 6-10, 13, 15-19, 22, 24-27, 49-50, 52, 54, 55, 57 and 58:

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Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and claim 1), and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to disclose the specific delivery requirements includes an electronic mail delivery notification. Fisher discloses a method for supplying automatic status updates using e-mail (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher, in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative. (See Fisher, columns 1 and 2).

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Fisher and Nichols discloses a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose simultaneously displaying the rates of the carriers to the user. Kara discloses a computer program used for multiple shippers that simultaneously displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

8. With respect to Claims 2, 11, 20, 29, 36 and 43: See Nicholls, Figure 4A.
9. With respect to Claims 3, 12, 21, 30, 37, and 44: See Nicholls, Column 7, lines 53-67.
10. With respect to Claims 5, 14, 23, 32, 39 and 46: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).
11. Claims 28-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholls et al (5,485,369) in view of Pauley et al. (4,958,280) and Kara et al. (6,233,568).
12. With respect to Claims 28, 31, 33-35, 38, 40-42, 45, 47, 48: Nicholls discloses the use of a shipping computer system (see abstract), with a method of using the system and a computer program located on the computer system, which instructs the computer to perform rate calculations (column 4, lines 8-24). Nicholls discloses each carrier having a set of shipping requirements and a predefined rate structure (column 2, lines 17-19, column 4, lines 49-55 and

claim 1); and identifying and displaying the carriers along with the rates of services, for each of the parcels according the rules (See Figures 4B, 4C and 4D, column 2, lines 32-38, column 7, lines 25-29 and claim 1) for each carrier. Nicholls discloses this system to be used over a global network (Column 3, lines 38-45).

Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to specifically disclose the proof of delivery is a verbal delivery notification. Pauley discloses the use of costumer service representatives which provide verbal communication of delivery status (Column 9, lines 34-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the notification by the customer service representative, as disclosed by Pauley, in order to allow users to obtain delivery information without the use of a computer. See Pauley columns 2 and 4).

Nicholls and Pauley disclose a multiple carrier system that calculates rates for carriers with specific parameters such as a notification of delivery, however Nicholls discloses the automatic selection of a carrier and fails to disclose displaying the rates of the carriers to the user. Kara discloses a computer program used for multiple shippers that displays that calculate shipping rates of multiple carriers for multiple services (See Figure 8, column 22, lines 20-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the shipping rates of Nicholls be displayed to the user as disclosed by Kara, in order to present the user with information from which to make an informed choice as to a particular shipping service provider by which to ship a particular item. (See Kara, column 22)

13. With respect to Claims 29, 36 and 43: See Nicholls, Figure 4A.

14. With respect to Claims 30, 37, and 44: See Nicholls, Column 7, lines 53-67.

15. With respect to Claims 32, 39 and 46: Nicholls discloses displaying a rate adjustment for the special service fees (See Figure 4D).

### ***Response to Arguments***

16. With respect to the specification objection with regards to the use of trademarks. The applicant has stated that these objections were fixed, however the applicant has failed to amend the specification in regards to any of the trademarks listed in the objection. The only trademark that was corrected was the ones used by iship.com. The trademarks with respect to the carriers listed in the objection are still objected to, as stated above.

17. Applicant's arguments filed 9/25/04 have been fully considered but they are not persuasive. The applicant is arguing the references on an individual basis and is not arguing the combination of references, as the rejections are based upon.

18. With respect to Applicant's argument that Nicholls, nor Fisher, nor Kara, nor Pauly, disclose the use of simultaneous identification of, display of and calculation of charges of respective carriers of a plurality of carriers that would provide a delivery notification: In terms of the previously presented claims, the word simultaneous is not claimed, this limitation only comes into the claims in the newly presented claim 58. Furthermore, as stated above, the applicant is arguing the references separately and not combined as they are in the rejection. Fisher is used only for the purposes of saying that a special service of a carrier is an electronic delivery notification. Nicholls is used for the identification of carriers that provide a special service and calculating the charges accordingly. Kara is used solely for the purpose of

simultaneously displaying the charges for multiple carriers. The *combination* of the three references provides the claimed limitations, and therefore the rejection stands as stated above.

19. With respect to Applicant's arguments that Pauly does not disclose the use of simultaneously providing identification of carriers that would provide verbal delivery notification. Again, as stated above, the applicant is arguing this reference alone, not the combination of references as applied in the rejection of claim 28. Pauly is merely used for showing that a delivery notification can be verbal. The examiner considers the combination of references as applied in the rejection provide the claimed limitations, therefore the rejection stands as stated above.

### *Conclusion*

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

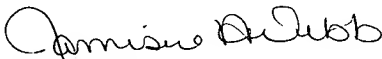


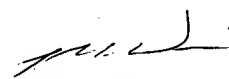
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~~Any inquiry concerning this communication or earlier communications from the~~  
examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579.  
The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the  
~~organization where this application or proceeding is assigned is 703-872-9306.~~

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